

REMARKS

Initially, Applicant has amended claims 169, 194, 221, 241-243, 250-257, 259-260 and 262 for cosmetic reasons unrelated to patentability. No new matter has been added.

5 Applicant believes that the following comments overcome the rejections set forth in the March 13, 2003 Office Action.

I. THE INVENTION

Generally, the present invention is a system for
10 accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium is a printed business card with a machine recognizable feature. The machine recognizable feature may be one of various embodiments including, but not limited to, a watermark, bar
15 code, invisible bar code, magnetic code, printed character, invisible icon, etc. When a machine recognizable feature is recognized, an electronic signal is transmitted for processing. The processing results in the display of programming material. The present invention is designed to
20 allow a user to access programming material that may be related to the information contained in the printed business card.

II. THE EXAMINER'S REJECTIONS

The Examiner rejected claims 168, 257 and 260 under 35 U.S.C. § 103(a) as being unpatentable over Withnall et al. U.S. Patent No. 4,488,015 (hereinafter referred to as "Withnall") and common knowledge in the art. Initially, the Examiner argued that Withnall discloses a transport system having a microprocessor-based, optical ticket reader that reads information from a printed ticket to determine and display the validity of the ticket. Also, the Examiner explained that a microprocessor-based ticket printer is used to issue bar-coded tickets. The Examiner then indicated that reference information is stored in memory, which communicates with the ticket-checking means.

However, the Examiner admitted that the "claims differ [from Withnall] in calling for the use of the business cards." The Examiner then contended that:

"[i]t would have been obvious to print the bar codes on the business cards. In this case, replacing a printed matter such as a book, a catalog, [or] a magazine, with a business card is merely a substitution of an art recognized equivalent." (March 13, 2003 Office Action, pp. 4-5).

Next, the Examiner rejected claims 169-194 and 258 under 35 U.S.C. § 103(a) as being unpatentable over Withnall "in view of the general teachings of the prior art of record." (March 13, 2003 Office Action, p. 5). The

Examiner admitted that Withnall fails to disclose a data link that carries certain types of data and video images, which the Examiner believed to be obvious. For evidence, the Examiner cited Thacher et al. U.S. Patent No. 5,033,271 (hereinafter referred to as "Thacher"), Ertz et al. U.S. Patent No. 5,003,577 (hereinafter referred to as "Ertz"), and Plummer U.S. Patent No. 4,992,824 (hereinafter referred to as "Plummer"). Thacher and Ertz were cited for describing various data links. Also, Plummer was cited for disclosing data links that transmit image and video information.

Additionally, the Examiner rejected claims 195-219, 259 and 261 under 35 U.S.C. § 103(a) as being unpatentable over Withnall "in view of the general teachings of the prior art of record." (March 13, 2003 Office Action, p. 6). The Examiner admitted that Withnall fails to disclose watermarks, invisible bar codes, magnetic codes, printed characters and invisible icons. The Examiner took Official Notice that the use of these features as a data input source was known. For support, the Examiner cited Konishi et al. U.S. Patent No. 5,237,156 (hereinafter referred to as "Konishi") and Younger U.S. Patent No. 5,151,637 (hereinafter referred to as "Younger"). The Examiner cited Konishi for disclosing a scanner for bar codes, magnetic

characters and character recognition. Younger was cited for acknowledging several types of "media-taped" materials.

Subsequently, the Examiner rejected claims 220-225 under 35 U.S.C. § 103(a) as being unpatentable over 5 Withnall and common knowledge in the art. The Examiner admitted that Withnall differed from the claims for not encoding various information in machine recognizable indicia, which the Examiner asserted to be obvious. The Examiner also noted that:

10 "a Court has decided that printed matter such as encoding particular information in a code, etc., would not be given patentable weight (In re Gulack, 217, U.S.P.Q. 401)." (March 13, 2003 Office Action, p. 7).

15 Also, the Examiner rejected claims 240-262 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Ishii et al. U.S. Patent No. 5,148,297 (hereinafter referred to as "Ishii"). The Examiner admitted that 20 Withnall does not disclose certain claimed display devices. The Examiner then took Official Notice that the use of certain display devices was known. As evidence, the Examiner presented Ishii, which disclosed for providing a liquid crystal display ("LCD").

25 Next, the Examiner rejected claims 241-256 under 35 U.S.C. § 103(a) as being unpatentable over Withnall and common knowledge in the art. Although the Examiner

admitted that Withnall fails to disclose certain code recognition devices, the Examiner took Official Notice that the use of such devices was known and old.

5 **III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN**

The Examiner rejected claims 168, 120-225, 241-257 and 260 under 35 U.S.C. § 103(a) as being unpatentable over Withnall and common knowledge in the art. Applicant respectfully disagrees with these rejections.

10 Specifically, Withnall does not disclose the programming material of the claimed invention. As the Examiner points out, Withnall discloses a system in which information read from the ticket may be displayed. Specifically, the Examiner notes that Withnall discloses:

15 "handset 24 which is adapted to be carried within the bus and enables an inspector to check tickets for validity. The portable handset is adapted to read information presented to it on a ticket in bar-code, and is capable of displaying
20 information read from the ticket in a form which can be read by the inspector." (March 13, 2003 Office Action, p. 4).

 This is distinct from the present invention. The
25 present invention utilizes the machine readable feature on the business card to access programming material. This programming material can then be displayed to the user. Withnall, on the other hand, scans a commuter ticket to

ascertain a validity state associated with that ticket. However, at no point does Withnall provide programming material. Therefore, Applicant respectfully submits that Withnall does not disclose the unobvious programming
5 material of the rejected claims and therefore, these claims are not obvious in view of Withnall and common knowledge in the art.

Also, the Examiner rejected claims 169-194 and 258 under 35 U.S.C. § 103(a) as being unpatentable over
10 Withnall in view of Thacher, Ertz and Plummer. Additionally, the Examiner rejected claims 195-219, 259 and 261 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Konishi and Younger. Also, the Examiner rejected claims 240-262 under 35 U.S.C. § 103(a)
15 as being unpatentable over Withnall in view of Ishii.

Applicant respectfully disagrees and submits that none of the aforementioned claims are obvious in view of the references cited against them. In order for a claimed invention to be obvious in view of a combination of
20 references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the

claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) MANUAL OF PATENT EXAMINING PROCEDURE §§ 2143-2143.03.

Initially, Applicant submits that there is no
5 suggestion or motivation to modify or combine Withnall with any of the aforementioned references.

10 "Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established
15 by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (Emphasis in original).

20 The Examiner contended that it would have been obvious to combine the teachings of Withnall with the aforementioned references to arrive at the various embodiments of Applicant's invention. Yet, the Examiner cited only purported benefits of the aforementioned
25 combinations and has not pointed to what motivation is provided by the references themselves. Applicant submits that no combination of these references would have been obvious to one of skill in the art at the time of Applicant's invention, especially because no motivation or
30 suggestion for combining these references exist within the

references themselves. Specifically, Withnall discloses a system for easing the examination of commuter tickets for validity. This has no apparent connection to Thatcher, which discloses a scoring system for video game
5 tournaments. Withnall also has no clear connection with Ertz's interface between a video terminal and a voicemail system. Additionally, Withnall does not relate in any way to Plummer's system for printing on a photosensitive film via an LCD. Moreover, Withnall lacks relation to Konishi's
10 apparatus for reading index information from images for expediting image registration. In addition, Withnall does not show any relation to Younger, which discloses an apparatus that logs information pertinent to "media-taped" material. Finally, there is no relation between Withnall
15 and Ishii, which discloses an LCD that provides better image quality when viewed at an angle. The differing purposes of these references have no overlap in use, and therefore, would not provide one skilled in the art with a motivation or suggestion to combine these references.
20 Thus, an inventive step must be performed for one skilled in the art to arrive at the idea of combining any features of Withnall, with any features of the aforementioned references.

Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a) rejections actually support an "obvious to try" argument. Of course, "obvious to try" is not the standard for obviousness under 35 U.S.C. § 103." *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

Under these circumstances, Applicant respectfully submits that the Examiner has succumbed to the "strong temptation to rely on hindsight." *Orthopedic Equipment Co. v. United States*, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed. Cir. 1983):

"It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law."

Applicant submits that the only suggestion or motivation for the Examiner's combination of references is provided by the teachings of Applicant's disclosure. No such suggestion or motivation is provided by the references themselves; nor could there be in view of the difference in subject matter and the corresponding goals thereof.

In view of the foregoing, base claims 168, 257 and 260 are patentable over any combination of Withnall and the

5 aforementioned references. The remaining rejected claims
are dependent on these claims and contain all of the
limitations of their respective base claims. Therefore,
these dependent claims are also patentable over these
references.

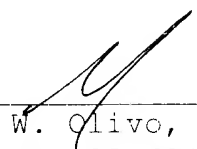
CONCLUSION

Applicant submits that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and
5 favorable action is accordingly solicited.

Respectfully submitted,

Date: _____

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